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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,575	04/26/2000	Wolfgang M. Strobel	P48-1229-1	9555

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EXAMINER

TSAI, HENRY

ART UNIT	PAPER NUMBER
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2183

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/558,575

Applicant(s)

STROBEL ET AL.

Examiner

Henry W.H. Tsai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121:

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

1. Note this Office Action is issued in response to the DECISION ON APPEAL filed on 8/22/02. Regarding the art rejections, Examiner agree with the board that reference Arnold could still be used to anticipate the claimed invention by different interpretations.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Arnold (USP 4,662,803) herein referred as Arnold.

Referring to claim 30, Arnold discloses as claimed a rotary cutting tool comprising: a first cutting portion (a portion of 18 near element 44 see Fig. 1) defining a first outer diameter

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(note as shown in Fig. 1, the portion of 18 near element 44 is best reasonably and broadly interpreted as defining a first outer diameter changing in a small range) and second cutting portion (12, see Fig. 1) defining a second outer diameter extending from and coaxial (along axis 20 see Fig. 1) with the first cutting portion; and wherein the second cutting portion (12, see Fig. 1) defines a generally cylindrical, outer peripheral surface; each of the first cutting portion (a portion of 18 near element 44 see Fig. 1) and second cutting portion (12, see Fig. 1) being defined in part by at least two helical cutting flutes (23, 24, 25, and 26, see Fig. 2) extending longitudinally (along axis 20 see Fig. 1).

As to claim 31, Arnold also discloses the first cutting portion (a portion of 18 near element 44 see Fig. 1) defining a tapered section (the partial portion of 18 between the first cutting portion (18, near element 44) and the second cutting portion 12, see Fig. 1) having a diameter that progressively decreases from the first outer diameter to said second outer diameter (the outer diameter of 12, see Fig. 1).

As to claim 32, Arnold also discloses the first cutting portion (a portion of 18 near element 44 see Fig. 1) and second cutting portion (12, see Fig. 1) being generally cylindrical. Note the portion of 18 near element 44 is best reasonably and broadly interpreted as being generally cylindrical since it

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defines a first outer diameter changing in a small range as shown in Fig. 1.

Note as described in Col. 3, lines 15-16, the flutes(23-26, see Fig. 2) on the forward portion(12) could be used to make a cylindrical enlargement of the hole prior to tapering.
Therefore, the portion 12 is considered as the second cutting portion.

Response to Amendment

4. Applicant's arguments filed 9/17/03 have been fully considered but they are not deemed to be persuasive.

Regarding the 35 U.S.C. §112, first paragraph and drawing problems, Applicant's response has completely overcome these objections and rejections.

Applicants argue that the rear portion (18), which encompasses the "first cutting portion" defined by the Examiner (i.e., "18, near element 44"), of the reamer in the Arnold patent is not "generally cylindrical" (from page 4, last paragraph to page 5, first line). Examiner does not agree with Applicants. As set forth in the art rejections above, Arnold's cutting tool comprises the portion of 18 near element 44 which is best reasonably and broadly interpreted as being generally

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cylindrical since it defines a first outer diameter changing in a small range as shown in Fig. 1. Note a "generally cylindrical" shape inherently has a small diameter change such as the portion of 18 near element 44 shown in Fig. 1.

Applicants further argue that the Arnold patent does not anticipate claim 30 of the present patent application because it does not disclose a first cutting portion defining an outer diameter as required by claim 30 of the present application (at page 5, second paragraph). Examiner does not agree with Applicants. As set forth in the art rejections above, as shown in Fig. 1, the portion of 18 near element 44 (the first cutting portion) of the Arnold's cutting tool is best reasonably and broadly interpreted as defining a first outer diameter changing in a small range. Note a diameter can be defined with a small range of change to the size thereof.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this

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action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Henry Tsai whose telephone number is (703) 308-7600. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, Eddie Chan, can be reached on (703) 305-9712. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2100 receptionist whose telephone number is (703) 305-3900.

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7. In order to reduce pendency and avoid potential delays, Group 2100 is encouraging FAXing of responses to Office actions directly into

the Group at fax number: 703-872-9306

This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Group 2100 will be promptly forward to the examiner.



HENRY W. H. TSAI
PRIMARY EXAMINER

November 2, 2003